

Remarks

Status of the Claims

Claims 19-22, 24-37 and 50-98 are in the application, of which claims 19, 36, 62, 65, and 66 are in independent form.

Restriction and Election of Species

Applicant acknowledges the examiner's withdrawal of the restriction between Group I (original claims 1-18 and 38-46, directed to a system and a machine) and Group II (original claims 19-37, directed to a method and a computer program). Applicant intends to amend the application upon allowance of the method claims, to rejoin cancelled system and machine claims having limitations corresponding to those of the method claims.

In the first Office action, dated March 22, 2005, the examiner identified five species within Group II (Species II-A, II-B, II-C, II-D, and II-E) and required applicant to elect one for examination. The first Office action did not identify any particular claims alleged to fall within or correspond to any of the five species, but required applicant to identify the claims reading on the species elected by the applicant in response to the Office action. When responding to the first Office action, applicant provisionally elected Species II-A, which was described in the first Office action as a method and apparatus that calculates a future volatility of a financial market. Applicant asserted that claims 19-22, 24-37, and 50-98, as amended, were readable on Species II-A.

The present second Office action, dated October 3, 2005, states that:

“The examiner points out that the applicant while provisionally electing species II-A (as specified in the prior office action species II-A contains embodiments II-A through II-E reciting mutually exclusive features. As an example, Species II-B (claim 28) recites checking opening time, II-C (claim 31) recites correlation matrix, II-D (claim 33) recites calculating hedging factor and II-E (claim 34) recites calculating a price at which to offer to buy a previously placed bet.”

(October 3, 2005 Office action at p 2.) Following this statement, the Office action concludes that claims 28, 31, 33, and 34 are deemed withdrawn as being drawn to a non-elected species, there being no allowable generic or linking claim. Applicant traverses the species restriction and respectfully requests reconsideration.

Neither the first Office action nor the present Office action set forth any rationale as to why the species identified (Species II-A to II-E) are independent or distinct. The second Office action makes a naked assertion that the species are mutually exclusive, but does not present any reasoning in support of this conclusion. Also, to date no examination

on the merits has been performed to determine whether any of the linking claims recognized by the Office are indeed unallowable, as the Office action asserts.

Furthermore, applicant argues that the Office action erroneously concludes that the identified species are mutually exclusive. For example, Species II-C, directed to a correlation matrix, plays a role in predicting market volatility for complex bets on the performances of several different markets. *See e.g.*, specification at p. 10, first full paragraph. Thus, species II-C is related to species II-A (calculation of future volatility) for complex bets in which calculation of a correlation matrix would be desirable. As a further example of the impropriety of the species restriction, applicant notes that calculation of a hedging factor (Species II-D) and calculating a price at which to buy a previously-placed bet (Species II-E) are related in that they are both directed to ways of reducing the financial exposure of an administrator of the claimed method and system. Other relationships between the identified species exist. Applicant therefore asserts that the Office has failed to make out a *prima facie* case in support of the restriction requirement and impermissibly shifts the burden to applicant to rebut an unsupported restriction.

In the event that the species restriction is upheld, applicant requests that it be made final so that applicant may have an opportunity to petition to the Director for review. 37 CFR § 1.144.

Rejection Under 35 U.S.C. § 112, ¶ 2 – Undue Multiplicity

The present (second) Office action rejects claims 19-37 and 50-98¹ under 35 U.S.C. § 112, second paragraph, stating that “taken as a whole the claims recite an undue multiplicity” and “the unreasonable number of claims would tend to obfuscate, confuse, and becloud the claimed invention.” October 3, 2005 Office action at p. 3 (citing MPEP 2173.05(n)). Applicant respectfully traverses and requests reconsideration.

The Office action fails to include any analysis of how the pending claims might tend to obfuscate or becloud the invention. No specific examples of confusing or beclouded claims, claim terminology, or claim elements are cited in the Office action. The Office action merely states that “the examiner believes that in his judgment that twenty (20) claims are sufficient to properly define applicants’ [*sic applicant’s*] invention”. October 3, 2005 Office action at p. 3 (emphasis added). In support of this position, the Office action recites statistics from a 1998 advance notice of proposed rulemaking that

¹ This rejection is construed by applicant as a rejection of claims 19-22, 24-37 and 50-98, since claim 23 was cancelled in response to the first Office action.

contemplated changes in the rules to limit the number of claims that could be filed in an application. This rulemaking notice *itself* proposed that 40 total claims would be a reasonable limit. *See* 63 Fed. Reg. at 53508. Moreover, upon receipt of public comments in response to the 1998 notice, the Office later abandoned its plans to limit the number of claims that could be filed. *See* Changes to Implement the Patent Business Goals, 64 Fed. Reg. 53772, 53774-75 (Proposed Rule, October 4, 1999). Such claim limits were presumably abandoned for the same reasons as expressed in the comments received in response to the 1998 notice, including that decisions by the Federal Circuit leave such uncertainty as to how claims will be interpreted that additional claims are necessary to adequately protect the invention, that applicants (and not the Office) should be permitted to decide how many claims are necessary to adequately protect the invention, and that limiting the number of claims would simply result in more continuing applications. *Id.*

Applicant notes that the Office has recently proposed another rule change that would require applicants to designate no more than 10 claims for examination and, for applications including more than 10 independent and/or designated claims, to prepare an examination support document. *See* Changes to Practice for the Examination of Claims in Patent Applications, 71 Fed. Reg. 61 (Proposed Rule, January 3, 2006). However, it remains to be seen whether the proposed rules will be adopted.

As was pointed out in some of the comments summarized in the 1999 notice cited above, the Office could accommodate larger numbers of claims by setting excess claims fees at a level sufficient to cover the cost of examination and to credit examiners based on the number of claims in an application. As noted in the present Office action, the USPTO has recently implemented one of these suggestions by increasing excess claims fees. However, while the recent fee increases do indeed reflect and offset the additional burden on the Office to examine a large number of claims, they are not evidence of whether a particular number of claims would tend to obfuscate the invention. There are presently 5 independent claims and 67 total claims pending in this application. Applicant has paid all claims fees due under the rules and should not be further subjected to limiting the number of claims in the absence of any such regulation or of any evidence of actual repetition or undue multiplicity in the claims, including an analysis of how the invention claimed in this application is obfuscated by any such alleged repetition or multiplicity.

The Office action presents no such evidence of repetition or confusing multiplicity of claims. Nor does the Office action present any analysis that would tend to show the invention is obfuscated or beclouded by the number of claims presented. As the Office

has recognized, “the CCPA has declined to hold that the presentation of any particular number of claims is so excessive as to confuse or obscure the inventions defined by the claims.” See 63 Fed. Reg. at 53507 (citing *In re Wakefield*, 422 F.2d 897, 164 USPQ 636 (CCPA 1970); and *In re Flint*, 411 F.2d 1353, 162 USPQ 228 (CCPA 1969)). See also *Ex Parte Birnbaum*, 161 USPQ 635, 637 (Pat. Off. Bd. App. 1968) (“While forty pages of claims may seem to be unnecessarily prolix, the mere psychological reaction to this amount of material does not, in and of itself, constitute a legal basis for rejection. The examiner must show either that the claims are so unduly multiplied that they are difficult to understand, making examination almost impossible, or that the claims are for the most part duplicates.”). Because the Office action does not present any examples or analysis of particular claims, terminology, or repetition that allegedly obfuscates or beclouds the invention, legal precedent dictates that the rejection be withdrawn. See *In re Flint*, 411 F.2d at 1356-57. For the examiner’s convenience, copies of the court’s decision in *Flint* and the Board’s decision in *Birnbaum* are included in an Appendix to this response.

As recognized at page 5 of the Office action, this case is complex. Indeed, it is the complex and interdependent nature of different aspects of the claimed invention that have prompted applicant to include the 67 total claims currently pending. However, applicant respectfully disputes any allegation that the claims themselves are unduly complex or difficult to understand. Applicant has presented the claims in a good faith attempt to secure the coverage that is believed needed for the invention, and argues that the present case is not one of those rare cases for which a multiplicity rejection is appropriate. See MPEP 2173.05(n) (“Undue multiplicity rejections . . . should be applied judiciously and should be rare.”) (emphasis added).

The Office action also presents a second ground for the multiplicity rejection, namely that the application includes a “multiplicity of inventions.” October 3, 2005 Office action at p. 3, last paragraph. This appears to be merely a surrogate for an improper restriction requirement. Moreover, the so-called “multiplicity of inventions” are in fact described in the Office action as “mutually exclusive species.” The Office action cites examples of new claims considered by the examiner to be directed to mutually exclusive species (i.e., claims 67-69 reciting species of financial markets, and claims 70-74, 76 reciting species of parameters), but fails to set forth all alleged species or to allege that the species are unduly numerous. Instead, the Office action impermissibly shifts the burden of examination to the applicant by asking applicant to “group the claims according to what he believes to be distinct inventions that may be restricted in a subsequent action.”

Moreover, in the event that a species restriction can be properly made (which applicant disputes), the applicant is still entitled to have the claims examined on the merits based on the previously-elected Species II-A, including all linking claims. *See* MPEP §§ 809, 821.03. By making the multiplicity rejection on grounds of multiple inventions, the Office action seems to avoid expressing the rationale required to support a proper restriction requirement, and thereby improperly circumvents examination on the merits.

Notwithstanding the foregoing arguments, in the event that the Office maintains the multiplicity rejection, applicant hereby *provisionally* selects claims for examination on the merits as follows:

- In the event that a species restriction is applied as to claims 28, 31, 33, 34, and 66-98, applicant *provisionally* selects claims 19, 20, 24, 26, 29-30, 36, 50-52, 55, 57-65 for examination, in response to the multiplicity rejection.
- In the event that the species restriction is withdrawn, applicant *provisionally* selects claims 19, 26, 36, 50, 51, 55, 59, 61, 62, 65-67, 70, 73-76, 82, 94, and 97 for examination, in response to the multiplicity rejection.

Upon withdrawal of the multiplicity rejection, applicants are entitled to examination of all pending claims (claims 19-22, 24-37, and 50-98) that are not subject to restriction.

The examiner's attention is also drawn to MPEP 2173.05(n), which indicates that in making a multiplicity rejection, an examiner should contact the applicant by telephone and ask the applicant to select a specified number of claims for examination. The MPEP then directs the examiner to examine the claims on the merits in the next action following the applicant's selection of claims. In this case, it seems that no attempt was made to contact the undersigned attorney by telephone. Rather, the present Office action states that a written action was sent as a courtesy, due to the complexity of the case, but included no examination on the merits. Applicant believes that proper adherence to USPTO procedures mandates that the next Office action include an examination on the merits, regardless of whether the multiplicity rejection is maintained, and that any rejection be made non-final so that applicant may have a fair opportunity for reply on the merits.

Applicant also wishes to remind the examiner of the guidance of the Manual of Patent Examining Procedure that:

“Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and

the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied . . .”

“The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.”


MPEP § 706.07. In the event that the Office identifies any issues that may be easily resolved, the examiner is invited to contact the undersigned attorney by telephone.

Conclusion

Applicant believes the species restriction and undue multiplicity rejection are improper, seeks withdrawal of the rejections, and earnestly solicits examination on the merits and allowance of the claims.

Respectfully submitted,

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Ex parte BIRNBAUM

Patent Office Board of Appeals

Patent issued Mar. 18, 1969

Opinion dated July 29, 1968

United States Patents Quarterly Headnotes

PATENTS**[1] Claims -- Duplicate or redundant (§ 20.40)**

While 40 pages of claims may seem to be unnecessarily prolix, mere psychological reaction to this amount of material does not, in and of itself, constitute legal basis for rejection; examiner must show either that claims are so unduly multiplied that they are difficult to understand, making examination almost impossible, or that claims are for the most part duplicates.--Ex parte Birnbaum (PO BdApp) 161 USPQ 635.

PATENTS**[2] Claims--"Means" claims (§ 20.65)**

Claim may be cast in form of means for performing a specified function, in which event it is construed to cover corresponding structure described in specification and equivalents thereof necessary to perform specified function in accordance with third paragraph of 35 U.S.C. 112.--Ex parte Birnbaum (PO BdApp) 161 USPQ 635.

PATENTS**[3] Construction of specification and claims--Broad or narrow--In general (§ 22.101)**

Terms in claim in application are given broadest reasonable interpretation.-- Ex parte Birnbaum (PO BdApp) 161 USPQ 635.

PATENTS**[4] Claims--Process (§ 20.80)**

Process claims are not rejected as merely reciting inherent function of the apparatus. -- Ex parte Birnbaum (PO BdApp) 161 USPQ 635.

PATENTS**Particular patents--Laser**

3,434,072, Birnbaum, Continuous Wave Laser Arrangement, claims 2 to 6, 8 to 18, 20 to 24, and 26 of application allowed; claims 1 and 7 refused.--Ex parte Birnbaum (PO BdApp) 161 USPQ 635.

***636 Appeal from Group 260.**

Application for patent of Milton Birnbaum, Serial No. 263,964, filed Mar. 8, 1963. From decision rejecting claims 1 to 18, 20 to 24, and 26, applicant appeals. Affirmed as to claims 1 and 7; reversed as to remaining claims.

DON B. FINKELSTEIN, Los Angeles, Calif., for applicant.

Before KREEK, ANDREWS, and STRADER, Examiners in Chief.

KREEK, Examiner in Chief.

This is an appeal from the final rejection of claims 1 to 18, 20 to 24, and 26, all of the claims in the case.

References of record relied on:

Dickie 2,851,652 Sept. 9, 1958

Parker et al. 3,191,157 June 22, 1965

Kleppner et al. "Properties of the Hydrogen

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Maser", Applied Optics, vol. 1, No. 1, pages 55-60, January 1962.

Rabinowitz et al. "Continuous Optically Pumped Cs Laser", Applied Optics, vol. 1, No. 4, pages 513-516, July 1962.

The claims have been rejected under 35 U.S.C. 112 for various reasons which we need not detail at this point as they will be discussed below. Claims 1 to 5 and 7 to 9 have been rejected on prior art; although in response to a multiplicity rejection and a consequent requirement to select representative claims, only claims 1, 2, 7, 14, 18, 20 and 26 were selected by appellant for prosecution. From this, we conclude it is the examiner's position that claims 14, 18, 20 and 26 are patentable as far as the prior art relied on is concerned.

Claims 1 to 5 were rejected as follows:

"Claims 1-5 stand finally rejected under 35 U.S.C. 103 as being unpatentable over Kleppner et al.

In Figure 2 of Kleppner is shown a maser containing (1) an atomic hydrogen source which emits a beam of particles in a first direction where the beam of particles is substantially homogenous in the ground energy state, (2) a state selector whose purpose, is to concentrate the particles in the $F=1$ energy level, and (8) a pickup loop which functions to couple the electromagnetic radiation from the cavity into a wave guide. The direction in which the beam travels through the waveguide is clearly a matter of choice.

The essence of applicant's position here appears to be that the pickup loop does not "extract a beam". As was pointed out above, the phrase "means to extract a beam" is not aptly descriptive of applicant's structure. However, in both Kleppner's microwave maser and applicant's optical maser, there is no "beam" inside the maser. The coherent beam of electromagnetic radiation which corresponds to a certain energy transition is the desired output."

Claims 1 to 5 are of varying scope and consequently have different limitations therein. The examiner has not pointed out wherein the terms of the claims find response in Kleppner et al., nor why this reference makes the claimed device obvious to one skilled in the art. However, it seems to us that Kleppner et al. meet the terms of claim 1. Hydrogen is disclosed by appellant as a material suitable for his device, thus, the hydrogen source and stop of Kleppner et al. constitute means for generating a continuous beam of optically orientable particles which obviously have a plurality of allowable quantum energy levels.

The next means clause is satisfied by the state selector of Kleppner et al. The last means clause is satisfied by the resonant cavity and the pickup loop which extracts energy from the cavity. We attach no particular significance to the term "beam". In any event, the particles enter the resonant cavity in the form of a beam, and the output energy in the wave guide or coaxial cable may be considered as a beam.

The claim is in no way limited to a laser. We will sustain the rejection of claim 1 on Kleppner et al.

Claims 2, 4 and 5 require means for optically inducing preselected quantum energy transitions. Nothing in Kleppner et al. suggests the use of optical means. We will not sustain the rejection of these claims on Kleppner et al.

Claim 3 appears to require, as argued by appellant, means for raising the beam in the tuned cavity of Kleppner et al. to a still higher energy level. It has not been made apparent to us how *637 this is made obvious by Kleppner et al. Therefore, we will not sustain the rejection of claim 3 on this reference.

Claims 1 to 5 have been finally rejected under 35 U.S.C. 103 as being unpatentable over Rabinowitz et al. Again the examiner has failed to apply the terms of any of these claims to the reference disclosure. It is not apparent to us that appellant's arguments as to patentability of these claims vis-a-vis the Rabinowitz et al. patent are erroneous. Thus, we will not sustain this rejection of claims 1 to 5.

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Claim 7 has been finally rejected under 35 U.S.C. 102 as being fully met by Dicke. We find no error in this rejection, therefore, it will be sustained.

Claims 8 and 9 have been rejected under 35 U.S.C. 103 as being unpatentable over Parker et al. We find nothing in this patent to indicate that the reflective surfaces of the walls are anything but reflective, therefore, we fail to see how it tends to make any of the walls partially transparent as required by the claims. Therefore, we will not sustain the rejection of claims 8 and 9 on Parker et al.

[1] All of the claims have been rejected on the ground of multiplicity. While forty pages of claims may seem to be unnecessarily prolix, the mere psychological reaction to this amount of material does not, in and of itself, constitute a legal basis for rejection. The examiner must show either that the claims are so unduly multiplied that they are difficult to understand, making examination almost impossible, or that the claims are for the most part duplicates. The examiner appears to rely on the latter. His position is stated in the Final Rejection as follows:

" * * * * The barest skeleton of applicant's invention includes the particle beam with its source, the magnetic field, the laser cell which permits a particle beam to be transmitted therethrough, a vacuum chamber, a resonant cavity, and a continuously operated optical pump lamp. Claims 1-5, 7-10, and 23 merely recite this fundamental skeleton with varying degrees of indefiniteness. Hence, claims 1-5, 7-10 and 23 are substantial duplicates. Claims 6, 11, 12, 13, and 24 differ from this first group of claims only in providing for a plurality of secondary beams. Hence, claims 6, 11, 12, 13, and 24 are also substantial duplicates. Claims 15, 16, 17, and 26 differ from this latter group of claims only in the provision of circularly polarized light for aligning certain particles. Hence, claims 15, 16, 17, and 26 are also substantial duplicates. The only additional limitations recited in the remaining claims are for filters and slits, and for the particular design

of the "source" of Figure 8. It is evident from the above discussion that the invention can be adequately protected by seven (7) claims."

and in the Answer as follows:

"As was pointed out above, in order to be complete a claim needs to recite: a) the source for the particle beam, b) the magnetic field generator, c) the laser cell with its associated resonant cavity, and d) the continuously operated optical pumping lamp. In the final rejection it was pointed out that claims 1-5, 7-10 and 23 are substantial duplicates in that they recite no more than these four essential elements, and that the more the claims approach completeness, the more they will be substantially duplicated. The remaining claims were also sorted out into substantially duplicated groups in the final rejection.

It would seem from this, that the examiner would require the appellant to present a claim including all of the elements which the examiner considered essential for a complete operative device, and having done this, any more claims would be merely a duplication. We are far from persuaded by the examiner's analysis that there is any substantial duplication of claims. Therefore, this rejection will not be sustained.

In the first paragraph on page 2 of the Answer, the examiner states it is necessary that four elements be claimed. Presumably claims 1 to 9 and 23, 24 and 26 are thought by the examiner not to meet this requirement. No claim analysis has been made under this heading, so it is not clear to us what exact point is intended to be made. Claims 7, 8 and 9 are drawn to the subcombination of the laser cell, per se. Such subcombination type of claim has long been accepted as a proper type of claim. Obviously, this subcombination does not require all of the elements enumerated in paragraph 1.

[2] This leaves us without sufficient information as to the examiner's position with respect to paragraph 1 to make a specific ruling with respect thereto. However, we note that a claim may be

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cast in the form of means for performing a specified function, in which event it is construed to cover the corresponding structure described in the specification and equivalents thereof necessary to perform the specified *638 function in accordance with 35 U.S.C. 112, third paragraph. Therefore, if a magnetic field, or other element, is in fact necessary to accomplish a specified function it is necessarily included in the claim.

In paragraph 2, page 2 of the Answer, the examiner, without identifying specific claims, states that the phrase "quantum energy level" has been inaccurately used. By referring to the final rejection it would appear that claim 14 is illustrative of such claims.

In view of appellant's disclosure that the particles of Figure 2 enter the cell at one quantum energy level; i.e., at F=2 level of the S 1/2 ground state and are pumped by optical means to a higher level which does not appear to be denied by the examiner, and in view of appellant's arguments relative thereto, we are not impressed by the soundness of this rejection. Therefore, we will not sustain the rejection set forth in paragraph 2.

[3] The examiner in paragraph 3, page 3, takes the position that "optical pumping" has taken on a specialized meaning in the laser art, but he does not deny that it may have a broader meaning. He does not assert that the term, as used herein is improperly used in its broader sense. It is well established that terms in a claim will be given their broadest reasonable interpretation. Therefore, we will not sustain the rejection of whatever claims may be embraced by paragraph 3.

In paragraph 4, page 3 of the Answer, the examiner states that the phrase "optically orientable particles" is unduly broad and indefinite. He states that the ten named elements disclosed in the specification should be claimed as a Markush group.

We agree with appellant as stated in his reply brief that the examiner was in error in this rejection. The examiner in his Supplemental Answer merely

reiterates the rejection which was made for the first time in the Answer.

[4] Claims 23, 24 and 26 were rejected as merely reciting the inherent function of the apparatus. In view of the recent decision, *In re Zoltan Tarczy-Hornoch*, 158 USPQ 141, we will not sustain this rejection.

A further rejection is stated as follows:

"6) Several phrases in the claims are indefinite in that they are statements of desired results which are recited as means plus function. There are no disclosed structural elements which correspond to these "means":

a) Claims 1-6 recite a "means for continuously extracting a coherent beam." This statement of function is the desired result of the entire laser. There is no disclosed structure, separate from the other recited structure which performs this function. Also, the active function of "extracting" is not performed at all in applicant's laser, and no structure is recited from which a beam can be extracted.

b) Claims 10, 11 and 15 recite a "means for inducing stimulated energy transitions". In a laser, the only thing which can stimulate an energy transition to a photon. In applicant's laser, these stimulating photons will inherently appear. There is no structure, separate from the other recited structure, which performs this function."

This rejection was stated for the first time in the Answer. Appellant points out in his reply brief that structure is involved. The examiner, in his Supplemental Answer, merely reiterates the rejection as set forth in the Answer.

Under the provisions of 35 U.S.C. 112, the claim covers the structural elements disclosed by the specification, or their equivalents, necessary to perform the stated function. Therefore, we will not sustain these rejections.

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In summary, on the basis of the rejection as stated by the examiner, primarily referring to his Answer, we sustain the rejection of claims 1 and 7 based on prior art, and will not sustain the remaining rejections.

The decision of the examiner is affirmed as to claims 1 and 7, and reversed as to claims 2 to 6, 8 to 18, 20 to 24, and 26.

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APPLICATION OF FLINT

Cite as 411 F.2d 1353 (1969)

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take, or deception when used on the identical and closely related goods.

[1] The appellant acknowledges that "there is no correct pronunciation of a trademark." We think that one is very likely to pronounce "Collegienne" as if it were spelled "Colleejen" or "Colleejun." Thus, in sound, the appellant's mark differs from the registered mark primarily in that the former is the plural form of the latter, which we feel does not amount to a material difference in a trademark sense. *Wilson v. Delaunay*, 245 F.2d 877, 44 CCPA 1019 (1957). We feel that the two very similar marks, when applied to the same goods, would create a likelihood of confusion.

[2] The appellant has argued that third party registrations in the record would indicate the reference registration is a "weak" mark and therefore "less likely to be confused." The question still remains whether the marks viewed as a whole create a likelihood of confusion. *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 54 CCPA 1295 (1967). Third party registrations have very little weight on the issue.

The decision of the board is affirmed. Affirmed.



56 CCPA

Application of Hyland C. FLINT. Patent Appeal No. 8159.

United States Court of Customs
and Patent Appeals.
July 3, 1969.

Proceeding in matter of application for patent. The Patent Office Board of Appeals, serial No. 391,518 affirmed final rejection of involved claims

on ground that they were unduly multiplied, and the applicant appealed. The Court of Customs and Patent Appeals, Almond, J., held that claims of application for patent relating to invention involving improvement in spring seat and to unison action seat were erroneously rejected on ground that they were unduly multiplied.

Reversed.

Patents §101(5)

Claims of application for patent relating to invention involving improvement in spring seat and to unison action seat were erroneously rejected on ground that they were unduly multiplied. 35 U.S.C.A. § 112; Patent Office Practice Rules, rule 75(b), 35 U.S.C.A. App.

George A. Schmidt, Harold W. Milton, Jr., Birmingham, Mich., Donald P. Selvecki, Detroit, Mich., Barnard, McGlynn & Reising, Birmingham, Mich., attorneys of record, for appellant.

Joseph Schimmel, Washington, D. C., for the Commissioner of Patents; Lutrelle F. Parker, Washington, D. C., of counsel.

Before RICH, Acting Chief Judge, DURFEE and NEESE, Judges, sitting by designation, ALMOND and BALDWIN, Judges.

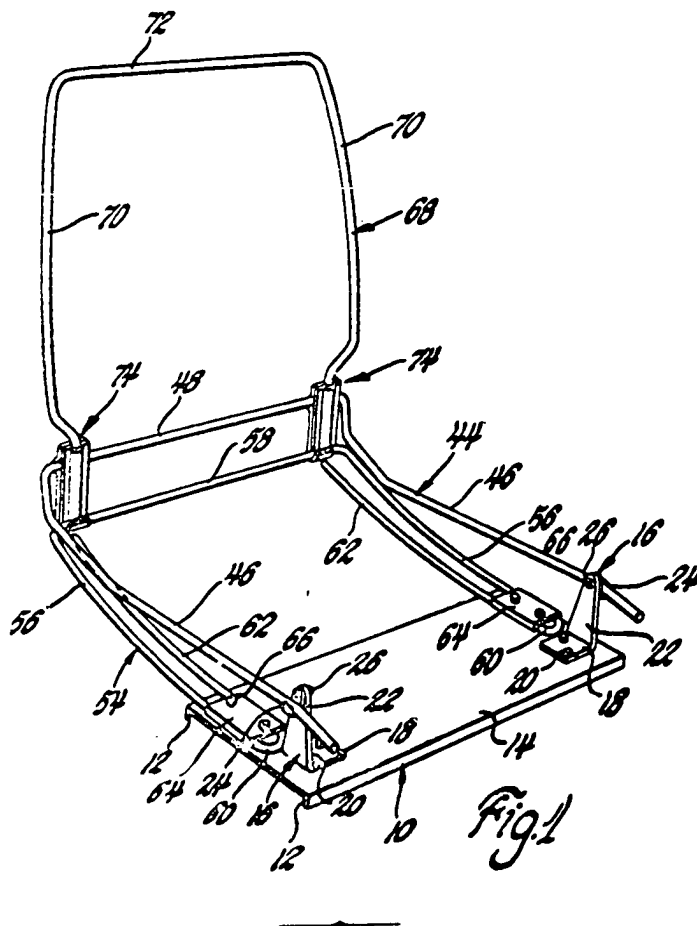
ALMOND, Judge.

This is an appeal from the decision of the Patent Office Board of Appeals affirming the final rejection of claims 1 to 6 and 9 to 44, all the claims remaining in appellant's application entitled "Spring Seat." ¹

The invention relates to an improvement in a spring seat and particularly to a unison action seat of the type which may be used in a vehicle or as a piece of furniture. As seen in Fig. 1, re-

1. Serial No. 391,518 filed August 24, 1964.

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produced here, appellant's seat comprises a base 10, a pair of L-shaped supporting brackets 16 mounted on base 10, and three generally U-shaped members 44, 54 and 68. Member 44 has leg portions 46 secured to base 10 by means of clips 24 pivotally mounted on brackets 16 and constitutes a seat-supporting wire. Member 54, also connected to base 10, serves as a resilient suspension spring. Member 68, extending upwardly from connecting member 74, is a back-supporting wire. Suitable cushion support

means, such as flexible sheet material or sinuous spring wire strips, may be mounted upon the seat support wire 44 and the back support wire 68.

The sole issue presented is whether the board erred in affirming the rejection of all 42 claims on the ground that they are unduly multiplied within the purview of 35 U.S.C. § 112.²

Claims 1 to 6 and 9 to 44 are all drawn to the disclosed seat. Claims 1, 12, 23 and 34 are independent claims which dif-

Rule 75(b) of the Patent Office Rules of Practice amplifies the statute and states:

"More than one claim may be presented provided, they differ substantially from each other and are not unduly multiplied."

2. The second paragraph of 35 U.S.C. § 112 requires the specification to conclude with:

"* * * one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

fer only in scope. C and 11, 13 to 22, 24 are like sets of depending, respectively, claims 1, 12, 23 and ones of the claims in same limitations to t they depend and thu other only in the ma independent claims di er. For example, cl 25 contain exactly tl cept for the number of each depends. We re 12 and 34, along wi respective dependent tive since they were lary by the board:

12. A seat com a base;

a U-shaped resi wire;

means pivotally of the legs of said to said base and

a U-shaped re spring having the thereof secured to member of said sus disposed in parallel the cross member o wire;

a U-shaped resil wire;

means pivotally of said back suppor members of said se said suspension movement of said with said seat sup substantial change between said back said base.

13. The seat set and further includi means secured to wire and to said k

14. The seat set wherein said cushi include a flexible sk legs of said seat su the cross member

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APPLICATION OF FLINT

Cite as 411 F.2d 1353 (1969)

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fer only in scope. Claims 2 to 6, 9, 10 and 11, 13 to 22, 24 to 33, and 35 to 44 are like sets of dependent claims depending, respectively, upon independent claims 1, 12, 23 and 24. Corresponding ones of the claims in those sets add the same limitations to the claim on which they depend and thus differ from each other only in the manner in which the independent claims differ from each other. For example, claims 2, 13, 24 and 25 contain exactly the same words except for the number of the claim on which each depends. We reproduce base claims 12 and 34, along with several of their respective dependent claims, as illustrative since they were treated as exemplary by the board:

12. A seat comprising:

a base;

a U-shaped resilient seat support wire;

means pivotally securing the ends of the legs of said seat support wire to said base and spaced therefrom;

a U-shaped resilient suspension spring having the ends of the legs thereof secured to said base, the cross member of said suspension wire being disposed in parallel spaced relation to the cross member of said seat support wire;

a U-shaped resilient back support wire;

means pivotally securing the legs of said back support wire to the cross members of said seat support wire and said suspension spring to permit movement of said back support wire with said seat support wire without substantial change in the angularity between said back support wire and said base.

13. The seat set forth in claim 12 and further including cushion support means secured to said seat support wire and to said back support wire.

14. The seat set forth in claim 13 wherein said cushion support means include a flexible sheet secured to the legs of said seat support wire and to the cross member of said suspension

spring, and a flexible sheet secured to the legs of said back support wire and to the cross member of said seat support wire.

17. The seat set forth in claim 13 wherein said cushion support means include a plurality of spring strips having oppositely disposed loops connected by straight portions, said spring strips extending laterally of said seat and being secured at the ends thereof to the legs of said seat support wire, and a plurality of spring strips having oppositely disposed loops connected by straight portions extending between and secured to the cross member of said back support wire and the cross member of said seat support wire.

34. A seat comprising:

a base;

a U-shaped resilient seat support wire pivotally supported in spaced relation on said base and extending rearwardly thereof, the cross member portion of said seat support wire being disposed rearwardly of said seat and in a plane spaced above the plane of pivotal support;

a U-shaped resilient suspension spring secured to said base and having the cross member portion thereof in parallel spaced relation and below said cross member of said seat support wire;

and a U-shaped resilient back support wire having the legs thereof pivotally secured to said cross members of said seat support wire and said suspension spring; said back support wire being movable with said seat support wire and with said suspension spring and pivoting about said pivot connection between said seat support wire and said base and pivoting about the flexure point of said suspension spring when said seat is loaded to maintain the angular relationship between said back support wire and said base.

35. The seat set forth in claim 34 and further including cushion support means secured to said seat sup-

sheet material or strips, may be support wire 44 wire 68.

nted is whether rming the rejection the ground that plied within the § 112.²

44 are all drawn Claims 1, 12, 23 claims which dif-

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ay be presented ostantially from unduly multi-

port wire and to said back support wire.

36. The seat set forth in claim 35 wherein said cushion support means include a flexible sheet secured to the legs of said seat support wire and to the cross member of said suspension spring, and a flexible sheet secured to the legs of said back support wire and to the cross member of said seat support wire.

39. The seat set forth in claim 35 wherein said cushion support means include a plurality of spring strips having oppositely disposed loops connected by straight portions, said spring strips extending laterally of said seat and being secured at the ends thereof to the legs of said seat support wire, and a plurality of spring strips having oppositely disposed loops connected by straight portions extending between and secured to the cross member of said back support wire and the cross member of said seat support wire.

Claims 1, 9 to 11, 23 to 25, 28, 31 to 34 and 42 to 44, provisionally selected by appellant for prosecution in response to the examiner's requirement that no more than fifteen claims be selected for examination on the merits,³ were indicated, by the examiner, as "avoid[ing] the prior art and be[ing] in allowable form," save for their inclusion in the undue multiplicity rejection.

In his Answer, the examiner defended his action in finally rejecting the claims as unduly multiplied by stating that "[i]n his opinion, the case is a relatively simple one * * * and that [42] claims * * * is an unreasonable number * * * and obscure[s] the

3. The examiner followed the procedure set forth in section 706.03(1) of the Manual of Patent Examining Procedure, which provides in pertinent part:

To avoid the possibility that an application which has been rejected on the ground of undue multiplicity of claims may be appealed to the Board of Appeals prior to an examination on the merits of at least some of the claims presented, the Examiner should, at the

invention." The examiner also stated that the average number of claims in each of six reference patents, sighted during the prosecution disclosing inventions of comparable complexity, was 7.5 claims.

In affirming, the board stated:

Turning to base claims 12 and 34, for example, they recite the same three U-shaped elements, differing only in verbiage as to their disposition and intended operation. It is, in our opinion manifest that no different cooperation exists between base claim 12 and its dependent claims 13-22 from that between base claim 34 and its corresponding dependent claims. Without even going into the other two columns of claims, we are convinced from the second and the fourth columns, i. e. headed by base claims 12 and [34], that the claims presented are unduly and needlessly multiplied with the result of beclouding the invention and not satisfying the Statute, 35 USC 112.

Appellant contends that the examiner's reasons for the rejection "were always based on his *feeling* or *opinion* that the claims were unduly multiplied." It is urged that something more than "mere opinion" is required to justify a rejection on the ground of undue multiplicity.

While agreeing that "mere opinion" is insufficient, a review of the record discloses, we feel, that the examiner was not relying upon an opinion based upon a sixth sense as the basis for the rejection but rather upon a conclusion drawn from the facts and legal principles applicable thereto as seen by him. In various office actions he set forth "typical examples of substantial duplication or lack of material differentiation," discussed the rela-

time of making the rejection on the ground of multiplicity of claims, specify the number of claims which in his judgment is sufficient to properly define Applicant's invention and require the Applicant to select certain claims, not to exceed the number specified, for examination on the merits. The Examiner should be reasonable in setting the number to afford the Applicant some latitude in claiming his invention.

tive complexity of the a lack of difference claims, and referred prior art.

The principles applicable situation are well established by this court in 319 F.2d 211, 50 CCPA

* * * applicants reasonable latitude claims in regard to nology employed. Thcants to freedom of phraseology which tr defines their invention abridged. Such la should not be extended degree of repetition which beclouds definition confusion. The rule be practiced and application of the relevant facts in each individual case

In the instant case it view that:

While a reasonable adding to the basic conventional element out the practical aspect is permissible, the same is repeated with which differ from each and do not provide additional relationships with of the base claims, the duly multiplied and the real invention in the complying with 35 USC the features added by claims were to be four prior art, their repetition than one base claim of scope is not justifiable reasons.

We do not agree. Viewed compared to judicially not board, that the dependent only conventional elements known. Moreover, the board acknowledges a difference between the base claims, persuasive appellant's arguments

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tive complexity of the invention, alleged
a lack of difference in scope of the
claims, and referred to representative
prior art.

The principles applicable to the present
situation are well established and were
stated by this court in *In re Chandler*,
319 F.2d 211, 50 CCPA 1422:

* * * applicants should be allowed
reasonable latitude in stating their
claims in regard to number and phrase-
ology employed. The right of appli-
cants to freedom of choice in selecting
phraseology which truly points out and
defines their inventions should not be
abridged. Such latitude, however,
should not be extended to sanction that
degree of repetition and multiplicity
which beclouds definition in a maze of
confusion. The rule of reason should
be practiced and applied on the basis
of the relevant facts and circumstances
in each individual case.

In the instant case it was the board's
view that:

While a reasonable number of claims
adding to the basic claimed structure
conventional elements, for rounding
out the practical aspect of the inven-
tion is permissible, where, as here, the
same is repeated with other base claims
which differ from each other in scope
and do not provide different combina-
tional relationships with the structure
of the base claims, the claims are un-
duly multiplied and tend to becloud the
real invention in the case, thus not
complying with 35 USC 112. Even if
the features added by the dependent
claims were to be found novel over the
prior art, their repetition with more
than one base claim differing only in
scope is not justifiable for the same
reasons.

We do not agree. We are not pre-
pared to judicially notice, as did the
board, that the dependent claims add
only conventional elements commonly
known. Moreover, the board's statement
acknowledges a difference in scope be-
tween the base claims, thus rendering
persuasive appellant's argument pointing

out that only four independent claims are
present, three of which have been held
allowable over the art, and that logically
the sets of dependent claims differenti-
ate themselves from each other by the
differences in scope of the independent
claims. Any fifteen claims could have
been selected for prosecution and found
allowable, it is urged, indicating that the
examiner was not confused by the fact
that 42 claims were involved.

We fail to see the fourfold repetition
of the same substance referred to by the
board and solicitor. The claims differ
from one another and we have had no
difficulty in understanding the scope of
protection. Nor is it clear, on this rec-
ord, that the examiner or board was con-
fused by the presentation of the claims
in the case or that the public will be.

The decision is accordingly reversed.

Reversed.

NEESE, Judge (concurring).

I concur with the result separately for
the sole purpose of respectfully disas-
sociating my views from those of the
majority to the extent that there is reli-
ance on *In re Chandler*, 319 F.2d 211, 225,
50 CCPA 1422 [3] (1963). That deci-
sion, giving sanction *sub silentio* to a pat-
ent examining procedure, Manual of Pat-
ent Examining Procedure, § 706.03(1),
which is inharmonious with 35 U.S.C.A. §
112, ought not to be followed, but re-
versed.

So important is the benefit of the gen-
ius, meditation and skill of creators and
innovators to our national sovereign and
its people, *Kendall v. Winsor*, 21 U.S.
(How.) 322, 16 L.Ed. 165, 167-168
(1859), that our Constitution grants to
the Congress the power " * * * to
promote the Progress of Science and use-
ful Arts, by securing for limited Times,
to Authors and Inventors, the exclusive
Right to their respective Writings and
Discoveries." Constitution, Art. I, § 8,
cl. 8. In implementation of such power,
the Congress has enacted statutory pro-
visions prescribing the extent and limi-
tations upon the right of the individual

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inventor to exclude others from the use of his invention. The inventor has no means of acquiring this right, except as permitted by these statutes. *Gayler et al. v. Wilder*, 10 U.S. (How.) 477, 494, 13 L.Ed. 504, 511 (1850).

35 U.S.C. § 112 requires that the specification for an invention conclude with " * * * one or more claims, particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." The Commissioner of Patents is authorized to promulgate regulations for the governance of proceedings in his office. 35 U.S.C. § 6, *United States ex rel. Steinmetz v. Allen*, 192 U.S. 543, 24 S.Ct. 416, 48 L.Ed. 555 (1904). In the exercise of this authority, such Commissioner promulgated a rule allowing an inventor to present multiple claims, as contemplated by the aforementioned statute, but added the provisos that such claims must " * * * differ substantially from each other and are not unduly multiplied." Rule 75(b), Patent Office Rules of Practice. This regulation served to erode administratively the statutory method of an inventor's acquiring a limited right of monopoly on his discovery in the public interest. No longer could he apply to acquire that right in the manner permitted by the Congress; thereafter, he was permitted to make multiple claims only if they differed one from another and were not "unduly" multiplied.

The Commissioner of Patents further eroded an inventor's statutory right by adopting an interpretative procedure to guide patent examiners in the consideration of applications of an inventor, which undertook to arrogate unto the examiners *carte blanche* authority to reject all claims of an inventor, particularly pointing out and distinctly claiming the subject matter which he regarded as his invention, if the examiner was of the opinion that a larger number of claims were made than were necessary to cover the invention, *viz.*:

An unreasonable number of claims; that is unreasonable in view of the

nature and scope of applicant's invention and the state of the art, affords a basis for rejection on the ground of *multiplicity*. A rejection on this ground shall include *all the claims* [emphasis added] in the case inasmuch as it relates to confusion of the issue. Manual of Patent Examining Procedure, § 706.03(1).

This court properly struck down the efficacy of that procedure nearly 30 years ago, when it stated:

We think it proper to observe * * * that the mere fact that a larger number of claims are made than are necessary to cover the invention is not sufficient to warrant rejection upon the ground of undue multiplicity of claims. * * * In *re Savage*, 110 F.2d 680, 27 CCPA 1048 (1940).

Some 17 years afterward, that rationale was accentuated for the court by Judge Rich with the more generalized observation that:

The patent statutes give to inventors the right to a patent upon compliance with their provisions, and neither the rules promulgated by the Patent Office nor the interpretation placed upon them can detract from those rights. 35 U.S.C. § 6.

Under 35 U.S.C. § 102 an applicant is "entitled to a patent unless" it is shown that one or another of the prohibitory provisions therein, or elsewhere in the statute, applies.

In *re Stempel*, 241 F.2d 755, 760, 44 CCPA 820, 826 (1957).

In the interim, the Patent Office Board of Appeals declined to affirm the rejection of a patent application on the ground of undue multiplicity, because there was " * * * no showing that the number of claims leads to confusion." *Ex parte Barnhill*, 68 USPQ 81 (1945). The board cited *In re Savage*, *supra*, in which we had also stated that rejection of a patent application on the ground of undue multiplicity was appropriate, only where the multiplied claims are of a character " * * * the net result of which is to

confuse, rather than to relative to an alleged invention it is claimed, involves invention

Even after we departed *re Savage*, *supra*, and approval of the aforementioned interpretative procedure, *supra*, *Idler*, *supra*, the administration continued, albeit reluctantly *Savage*, *supra*, *viz.*:

We do not wish to practice of presenting a number of claims in an application as it imposes a burden on the examiner to examine the matter as it here, the matter has been determined and there does not any uncertainty or mind of the examiner's claims cover, we are that in the interest of application should have * * *

We have no clear understanding of the subject matter and in various circumstances find the result unsustainable. [Emphasis] *parte King and Adol* 600 (1964).

The Supreme Court has held that:

The power of an officer or board to administer the statute and to prescribe regulations to that end to make laws * * * to adopt regulations which affect the will of Congress by the statute. A does not do this, but it is a rule out of harmony with the statute is a mere nullity.

Manhattan General Electric Co. v. Commissioner of Internal Revenue, 357 U.S. 129, 134, 56 S.Ct. 528, 531 (headnote 2), quoted from in *Dixon*, 381 U.S. 68, 74, 85 S.Ct. 223, 228 [5] (and see *fn. 7*) (1965). In dealing

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confuse, rather than to clarify, the issues relative to an alleged improvement, which, it is claimed, involves invention."

Even after we departed the rule of *In re Savage, supra*, and implied judicial approval of the aforementioned interpretative procedure, *supra*, in *In re Chandler, supra*, the administrative board continued, albeit reluctantly, to follow *In re Savage, supra*, viz.:

We do not wish to encourage the practice of presenting an unduly *large number of claims* in a patent application as it *imposes a great burden* on the examiner to examine the same. *Where, as here, the claimed subject matter has been determined to be patentable and there does not appear to be any uncertainty or confusion in the mind of the examiner as to what the claims cover*, we are of the opinion that in the interest of expediency *the application should have been allowed.*
* * *

We have no uncertainty regarding a clear understanding of the claimed subject matter and in view of all the circumstances find the rejection to be unsustainable. [Emphasis added.] *Ex parte King and Adolphson*, 144 USPQ 600 (1964).

The Supreme Court has made it clear that:

The power of an administrative officer or board to administer a federal statute and to prescribe rules and regulations to that end is not the power to make laws * * * but the power to adopt regulations to carry into effect the will of Congress as expressed by the statute. A regulation which does not do this, but operates to create a rule out of harmony with the statute, is a mere nullity.

Manhattan General Equipment Co. v. Commissioner of Internal Revenue, 297 U.S. 129, 134, 56 S.Ct. 397, 400, 80 L.Ed. 528, 531 (headnote 2), (1936), cited and quoted from in *Dixon v. United States*, 381 U.S. 68, 74, 85 S.Ct. 1301, 14 L.Ed.2d 223, 228 [5] (and see cases collected at fn. 7) (1965). In dealing with the effort

of another administrative agency to make, by rule and regulation, 18 U.S.C. § 1304 a crime, a unanimous Supreme Court observed that, while the agency could aid in implementing by either general rule or by individual decisions the applicable statute under which it administered a statute, " * * * the Commissioner's power in this respect is limited by the scope of the statute. Unless the 'giveaway' programs involved here are illegal under § 1304, the Commission cannot employ the statute to make them so by agency action." *F.C.C. v. American Broadcasting Co.*, 347 U.S. 284, 290, 74 S.Ct. 593, 597, 98 L.Ed. 699, 705-706 (headnote 2), (1954).

In like manner, the Commissioner of Patents can aid in implementing 35 USC 112 by either general rule or by individual decisions; but his power in this respect is limited by the scope of that statute. Even if the Patent Office may reject claims in a patent application which result in confusion, rather than in greater clarification, of the claims to an invention, *In re Savage, supra*, the scope of 35 U.S.C. § 112 does not authorize the wholesale rejection by agency action of all an inventor's claims, merely because a patent examiner deems overly burdensome the examining of a larger number of claims than he considers reasonable, in view of the nature and scope of the applicant's invention and the state of the art.

To permit such is to encourage government by men, rather than by law. An inventor is not permitted by law to monopolize his discovery in whatever manner he may prefer. He must make application to acquire his right of monopoly in accordance with law. His application must necessarily be considered by a patent examiner. The patent examiner, too, is not permitted by law to approve or reject a patent application in whatever manner he may prefer, but by law and valid regulation. If a patent examiner departs the law and such regulations, the only relief then available to the applicant is by appeal to the courts. 35 USC chap-

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ter 13, *Butterworth v. United States*, 112 U.S. 50, 5 S.Ct. 25, 28 L.Ed. 656, 660-662 (1884), construing and applying earlier provisions of these statutes; *In re Hien*, 166 U.S. 432, 17 S.Ct. 624, 41 L.Ed. 1066, 1069 (1897); *Cochrane v. Deener*, 94 U.S. 780, 24 L.Ed. 139, 140 (1877). All questions involved in the application for a patent may be reviewed by the courts. *Gardner v. Herz*, 118 U.S. 180, 6 S.Ct. 1027, 30 L.Ed. 158 (1886); *Reckendorfer v. Faber*, 92 U.S. 347, 23 L.Ed. 719 (1897). Where any divergence of views between the courts and the Patent Office proceeds from a different interpretation of the applicable statutes, the views of the Patent Office must be subordinated to those of the courts.

Steinmetz, supra, 192 U.S. 543, 24 S.Ct. 416, 48 L.Ed. at 562.

If this and similar courts fail to respond to pleas of inventors that patent examinations be accomplished harmoniously with the will of the Congress as expressed in statutes, there is in the offing a time when applications for patents will be approved or rejected on the basis of administrative regulation and procedural instruction. This is an unhappy prospect in a nation where men undertake to govern themselves by law. And it is for these reasons that I have urged that the misconception of *In re Chandler, supra*, not be compounded here, but that the rule of *In re Savage, supra*, be reaffirmed.

**UNITED STATE
Plaintiff-A**

v.
Guido FIDANZI, Def
No. 161

United States Court
Seventh Circuit
June 23,
Rehearing Denied

The United States Court for the Northern District of Eastern Division, Will found defendant guilty of failure to file returns of income tax. The Court of Appeals, Judge, held, inter alia, that the defendant's closing argument to appeal to sympathy, and the judge, court would not find evidence where evidence was that jury could not have decided to acquit, and the reasonable possibility that from such appeal, and which was relevant to filing fraudulent tax returns to file returns was not possible because it tended to show guilt of another crime. Affirmed.

1. Criminal Law §703,
Prosecutor could anticipate evidence in argument and, in his closing, mind jury of evidence produced and attempt to draw legitimate, relevant

2. Criminal Law §1171
Even if prosecutor's arguments were of nature to pathy, passion, and would not set aside conviction was of such nature not have conscientiously quit, and there was no ability that verdict resist appeal.

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